



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/428,453 | 10/28/1999 | SATORU MOTOHASHI | 35.C13980 | 4676 |

5514 7590 12/09/2002

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

| |
|----------|
| EXAMINER |
|----------|

RODEE, CHRISTOPHER D

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1756

DATE MAILED: 12/09/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-17

Office Action Summary

Application No.

09/428,453

Applicant(s)

MOTOHASHI ET AL.

Examiner

Christopher D RoDee

Art Unit

1756

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15,22,26,27 and 29-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15,22,26,27 and 29-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 15, 22, 26, 27, and 29-32 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The instant claims have been amended in response to the rejections presented in the last Office action. Although the amendments have resolved the issues concerning the amounts of the fluoroplastic particles and their particulate form, the amendments fail to resolve the issues concerning the relative difference in molecular weight between the two polycarbonates (i.e., all claims) and the claims directed to a cleaning system (i.e., claims 31 and 32).

As discussed in the last Office action, the specification discloses a charge transport layer formed from a solution containing a blend of polycarbonates (polycarbonate I and polycarbonate II) and fluoroplastic particles (p. 11, l. 16-21). In one embodiment, polycarbonate I has a viscosity-average molecular weight of 5000 and polycarbonate II has a viscosity average molecular weight of 20,000 (p. 12, l. 1-10). In another embodiment 30 to 95 parts by weight of polycarbonate I having a viscosity average molecular weight of 15,000 or less is combined with a polycarbonate II with unspecified properties (p. 13, l. 17-22). The examples present specific imaging members for devices, but the characteristics of the resins are not disclosed.

These disclosures do not provide basis for all resin combinations where the second polycarbonate has a higher viscosity average molecular weight than that of the first polycarbonate resin. The limited disclosures in the specification of charge transport layers with either a specific combination of viscosity-average molecular weights for the polycarbonates (p.

Art Unit: 1756

12) or more general disclosures (pp. 11 and 13) do not provide a description of all charge transport layers where the first polycarbonate resin has a viscosity average molecular weight of 15,000 or less and the second polycarbonate resin has a higher viscosity average molecular weight than that of the first polycarbonate resin. The claims include not only a second polycarbonate with a viscosity-average molecular weight of 20,000 but all viscosity-average molecular weights greater than that of the first polycarbonate. Thus, second polycarbonate Mv values of 16000, 19000, 50000, and on to the greatest possible are included within the claims' scopes. Values less than 20,000 for the second polycarbonates Mv as well as those substantially larger than 20,000 are permitted within the scope of the claims. However, the specification does not provide basis for such values.

Claims 31 and 32 remain rejection because there is no basis in the specification as filed for "a cleaning system" having only the photosensitive member and cleaning blade. The specification discloses an apparatus and a process cartridge (spec. p. 8, l. 19 - p. 9, l. 8) having certain means including those specified in claims 15 and 29, but there is no disclosure of a cleaning system having only the photosensitive member and a cleaning blade. The recent response does not remedy this lack of basis.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 1756

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D RoDee whose telephone number is 703 308-2465. The examiner can normally be reached on most weekdays from 6 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 703 308-2464. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9310 for regular communications and 703 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0661.

cdr
December 6, 2002



**CHRISTOPHER RODEE
PRIMARY EXAMINER**